

105(currently amended). A bone support plate assembly as in Claim 97 wherein said bone support plate and said second plate element ~~first and second plates~~ are made from material selected from the group consisting of titanium and stainless steel.

106(previously added). A bone support plate assembly as in Claim 98 wherein said first and second plates are made from material selected from the group consisting of titanium and stainless steel.

107(previously added). A bone support plate assembly as in Claim 99 wherein said first and second plates are made from material selected from the group consisting of titanium and stainless steel.

108(previously added). A bone support plate assembly as in Claim 100 wherein said first and second plates are made from material selected from the group consisting of titanium and stainless steel.

Remarks

No claims have been cancelled. No new claims have been added. Claims 93, 94, 97, 98, 99, and 105 have been amended to define the invention with more clarity. Applicant asserts that no claims have been narrowed within the meaning of Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., No. 95-1066, 2000 WL 1753646 (Fed. Cir. Nov. 29, 2000). Additionally, Applicant asserts that all amendments are supported by the application-as-filed and that no new matter has been added. Claims 93-108 remain in the application. Reconsideration of the application is requested in light of the foregoing amendments and following remarks.

Restriction/Election

The examiner withdrew Claims 94, 99, 102, and 105 from consideration, asserting that the respective claims require "*a spinal plate assembly in addition to the bone support plate assembly*". Applicant submits that the examiner has misread the claims. The respective claims recite that the *bone support plate assembly comprises a spinal plate assembly*. Thus, Claims 94 and 99, and Claims 102 and 105 which depend therefrom are merely being more specific than respective independent Claims 93 and 98 in that Claims 94 and 99 specify that the bone support plate assembly is used to support the patient's spine.

Thus, a proper reading of Claims 94, 99, 102, and 105, and the word "comprising" treats "*spinal plate assembly*" as a modifier of "*bone support plate assembly*", whereby "*spinal plate assembly*" does not, cannot result in first (bone support plate assembly) and second (spinal plate assembly) assemblies. To the contrary, the meaning of "*bone support plate assembly*" is modified by the phrase "*spinal plate assembly*".

Thus, e.g. Claim 93 is permissive of a plate assembly which is useful in some portion of the body, not limited to only the spinal area, although the spinal area is included. Claim e.g. 94 then is more limiting in that Claim 94 limits the assembly to being a spinal plate assembly. Accordingly, Applicant respectfully submits that Claims 94, 99, 102, and 105 do read on Species III (Figures 7 and 8), and should be re-joined into the application.

Rejection of Claims under 35 U.S.C. §112, 2nd Paragraph

Claims 97 and 105 stand rejected under 35 U.S.C. §112, 2nd Paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The examiner asserted that, in claim 97, line 2, "said first ... plates" lacks antecedent basis. Though not specifically stated, Applicant contemplates that the examiner intended to assert a corresponding specific rejection of Claim 105. Both Claims 97 and 105 have been amended to recite said bone support plate and said second plate element, which has proper antecedent basis in independent Claim 93, from which Claim 97 and Claim 105 depend. Withdrawal of the rejection is respectfully requested.

Double Patent Rejection

Claims 93, 95-98, 100, 101, 103-106, and 108 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 6-20 of US Patent No. 6,503,250. The examiner asserts that the recited claims are unpatentable over Claims 6-20 of the '250 patent.

Applicant respectfully traverses the rejection. However, in order to move the application toward allowance, Applicant encloses herewith a Terminal Disclaimer with respect to US Patent 6,503,250. Accordingly, the obviousness-type double patenting rejection is overcome. Withdrawal of the rejection is respectfully requested.

Rejection of Claims under 35 U.S.C. §102(b)

Claims 93, 95-98, 100, 101, 103-106, and 108 stand rejected as being anticipated by Baccelli (WO 99/04718). Applicant respectfully traverses the rejection.

The examiner states that the phrase "adapted to" is not a positive limitation but only requires the ability to so perform.

Independent Claims 93 and 98 have been amended to positively recite
said bone support plate assembly, when mounted to such first and second underlying bone structures, accommodating post procedural settling of at least one of such first and second bone structures with respect to the other of such first and second bone structures.

Baccelli does not teach or suggest accommodating any post-procedural settling. To the contrary, Baccelli teaches away from such post-procedural settling. Referring to the corresponding US 6,306,136: at column 1 lines 38-39, Baccelli states

this possibility of sliding renders the implant incapable of maintaining a desired spacing between the two vertebrae.

Baccelli further states at column 1 lines 44-50

The present invention aims to overcome these disadvantages of the prior art and to make available an implant...in which it is possible to

use a plate made up of two sliding elements in order to establish and maintain a compression of bone grafts which have been introduced between two vertebrae on which the implant is to be anchored (emphasis added by Applicant).

Thus, Baccelli first teaches against post-procedural movement of the plate elements (column 1 lines 38-39) and then teaches establishing and maintaining compression on the bone graft.

By contrast, Applicant teaches and claims accommodating post-procedural settling. Applicant submits that establishing and maintaining compression, as taught by Baccelli, is not compatible with, does not place the public in possession of, accommodating post-procedure settling, as taught and claimed by Applicant.

Accordingly, Applicant submits that Baccelli does not teach or suggest the claimed invention, indeed teaches away from the claimed invention which requires post-procedural movement/settling. In light of the above, Applicant submits that Claims 93, 95-98, 100, 101, 103-106, and 108 are patentable over Baccelli, and all other references of record.

Rejoinder of Claims

Now that independent (generic) Claims 93 and 98 are seen to be allowable, even if the examiner persists in his position that withdrawn Claims 94, 99, 102, and 108 do not read on the elected species, those claims which depend from allowed claims should be re-joined into the application and examined and allowed along with the claims which have already been actively examined. Accordingly, Applicant respectfully requests that withdrawn Claims 94, 99, 102, and 107 be re-joined into the application, and examined and allowed along with the remaining claims, whereby all of Claims 93-108 should be allowed.

Applicant thus submits that all claims as presented herein are allowable over all references of record. Allowance is respectfully solicited.

A small entity fee in the amount of \$55 is believed to be due for the accompanying Terminal Disclaimer. A check in the amount of \$55 is enclosed herewith to pay the fee for the Terminal Disclaimer. No other fee is believed to be due. Should any other fee be

properly due, or if any refund is due, kindly charge same, or credit any overpayment, to Deposit Account 23-2130.

Please feel free to contact me with any questions, comments or concerns, at the telephone number listed below.

Respectfully submitted,
Kamaljit S. Paul

By: Thomas D. Wilhelm
Thomas D. Wilhelm
Attorney for Applicant
(Reg. No. 28,794)

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Customer Number: 23482

Wilhelm Law Service
100 W. Lawrence Street, 3rd Floor
Appleton, Wisconsin 54911
Telephone: 920-831-0100
Facsimile: 920-831-0101